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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,678	12/11/2001	Scott Bluni	BSC-199 (1002/275)	3218

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EXAMINER
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BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

12

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/014,678

Applicant(s)

BLUNI ET AL.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-32 is/are pending in the application.
- 4a) Of the above claim(s) 4,9,10,20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8,11-15,17-19 and 22-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 4, 9, and 20-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species and sub-species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11. In addition, claim 10 is withdrawn by the Examiner as not reading on elected species II, wherein the distal portion of the elongated body is helical.

Applicant's election with traverse of Species II, sub-species i in Paper No. 11 is acknowledged. The traversal is on the ground(s) that there would not be a serious burden on the Examiner. This is not found persuasive because a species restriction does not require a showing of serious burden. MPEP 808.01(a) states, Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable difference between the species as claimed. See MPEP § 806.04(h). Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification." If the Applicant were to argue that the inventions are not independent, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3, 5-8, 11-15, 17-19 and 22-32 have been considered but are moot in view of the new ground(s) of rejection.

Contrary to Applicants arguments, the basket of Taylor is substantially buoyant relative to at least one body fluid. Taylor discloses that the basket can be made of polypropylene, which is well known to have a specific gravity of 0.90-0.92 (www.plasticsusa.com). Because urine, a body fluid, is essentially a solution of minerals, salts, and compounds dissolved in water, the specific gravity is greater than 1.000. Therefore, the polypropylene basket of Taylor is inherently substantially buoyant relative to at least one body fluid.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is a lack of antecedent basis for the term "bead".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 3, 7-8, 11-15, 17-19, and 22-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al. as cited in applicant's IDS. Taylor et al. discloses a medical device comprising: a perforated elongated body with a lumen that does not deform during insertion through a ureter (p 14, lines 24-29) thus substantially rigid, a substantially elastic tether connector (p 13, lines 24-25), and a substantially spherical fixation element larger than the lumen of the ureter (p 13, lines 2-4) that is inherently buoyant. In addition, Taylor et al. also discloses a medical device (Fig. 17) for inserting into a patient comprising: an elongated body with a lumen (155), substantially rigid tethers (151), and a plurality of retention modules (153) that are positioned in the bladder. Furthermore, the fixation device comprises a bead (123 in Fig. 11).

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsura et al. Matsura et al. discloses a medical device (Fig. 25C) comprising: an elongated body with a lumen (272), a tether (236), and a retention module comprising a fixation element (10) that can be a substantially helical spiral (p 8, lines 19-20).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. in view of Whitmore, III. Taylor et al. discloses a medical device as above,

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however Taylor et al. fails to disclose the proximal portion of the elongated body as more compressible than the distal portion. Whitmore, III teaches a ureteral stent with the proximal portion of the elongated body as more compressible than the distal portion so the distal portion can better resist the pressure from the adjacent tissue (p 1, paragraph 0006). It would have been obvious to one of ordinary skill in the art to combine the teaching of the proximal portion of an elongated body of a ureteral stent as more compressible than the distal portion, as taught by Whitmore, III, to a medical device as per Taylor et al., so the distal portion can better resist the pressure from the adjacent tissue.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

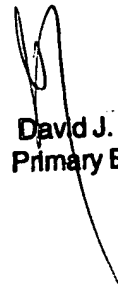
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read "Thomas Barrett".

Thomas Barrett

A handwritten signature in black ink, appearing to read "David J. Isabella".

David J. Isabella  
Primary Examiner